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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/645,827	08/25/2000	Date C. Flanders	1000-0006	4350
25263	7590	07/01/2003	EXAMINER	
J GRANT HOUSTON AXSUN TECHNOLOGIES INC 1 FORTUNE DRIVE BILLERICA, MA 01821			JOHNSON, JONATHAN J	
		ART UNIT	PAPER NUMBER	
		1725		

DATE MAILED: 07/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/645,827	FLANDERS ET AL.
	Examiner	Art Unit
	Jonathan Johnson	1725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 30 April 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 9-16 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-8 and 17-20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>16</u> . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Election/Restrictions

Applicant's election of Group I, claims 1-8 in Paper No. 15 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 17, 19, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Wolfgang et al. (SPIE Vol. 2906, Microrobotics: Components and Applications). With respect to Claims 1 and 3-8 and 17, 19, and 20, Wolfgang et al. teaches a supply area (Figure 6, Stock); a pick and place machine that picks and places the components to the work area (abstract and Section 5, first paragraph); and an aligner that characterizes the positions of the components on the bench and mechanically adjusts the relative position (section 5.3, paragraphs 1-4); an aligner that activates/energizes a workpiece and detects an optical signal and adjusts the components (Section 5.3, Paragraphs 1-4 and Figure 9a, measuring system); and a two jaw gripper (Figure

9a, gripper). It is the examiner's position that how the system operates is a process limitation that holds little patentable weight in an apparatus claim.

With respect to Claims 2 and 18, the teachings of Wolfgang et al. are the same as relied upon in the rejection of Claim 1 and 17. Wolfgang et al. teaches laser welding (abstract and Figure 4, laser). It is the examiner's position that how the components are secured are process limitations that hold little patentable weight in an apparatus claim.

Response to Arguments

Applicant argues that the claimed functions of machines should be given full patentable weight. Applicant, however, does not attempt to distinguish the instant case from the case law the examiner provided in the previous office action to show why the claimed functions in the instant application should be given full patentable weight. As stated in the previous office action, “[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim.” Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, “[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims.” In re Young, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in In re Otto, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)). The rejection is maintained despite applicant's traversal.

Applicant next argues that invoking 35 U.S.C. 112, sixth paragraph in Claim 17 should overcome the rejection. The examiner agrees that applicant's “means for characterizing” and “means . . . for mechanically adjusting” limitations invoke 35 U.S.C. 112, sixth paragraph. The examiner, however, does not agree with applicant's argument that by invoking 35 U.S.C. 112,

sixth paragraph, applicant's invention requires a system aligner to characterize the positions of the optical components, which are attached to the optical bench, and mechanically adjust their relative positions. In order to establish a *prima facie* case of equivalence, the prior art element must perform the identical function specified in the claim in substantially the same way, and produce substantially the same result as the corresponding element disclosed in the specification.

Kemco Sales, Inc. v. Control Papers Co., 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000). In the instant case, both the prior art and the instant case perform the identical function by bonding an optical component to an optical bench and both produce substantially the same function in substantially the same way as they align optical components and adjust their relative positions. It is the examiner's position that although adjusting the relative position of the optical component after being attached to the optical bench is a difference between the prior art and the instant invention, it does not rise to the level of overcoming the substantial similarities outlined in Kemco. The rejection is maintained despite applicant's traversal.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Johnson whose telephone number is 703-308-0667. The examiner can normally be reached on M-Th 7AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on 703-308-3318. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

jj 08
June 22, 2003



M. ALEXANDRA ELVE
PRIMARY EXAMINER